



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

TIMOTHY H. VAN DYKE
VAN DYKE & ASSOCIATES, P.A.
1630 HILLCREST STREET
ORLANDO FL 32803

COPY MAILED

JUN 26 2002

OFFICE OF PETITIONS

In re Application of :
Kevin C. Carter (Dec'd) & Diane :
Carter (Legal Rep.), Michael Esch, : DECISION REFUSING
Paul LaRochelle & Gina Scurti : STATUS UNDER
Application No. 09/924,110 : 37 CFR 1.47(a)
Filed: August 7, 2001 :
For: MATERIALS AND METHODS FOR
IMPROVED BONE TENDON BONE
TRANSPLANTATION

This is in response to the petition under 37 CFR 1.47(a), filed March 29, 2002.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing legal representative. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) and (2) set forth above.

As to item (1), rule 47 applicant must demonstrate with documented evidence that the legal representative of deceased inventor Kevin C. Carter refuses to join in the application after having been presented with the application papers (specification, claims, drawings and oath or declaration). There is no indication in the present case whether the legal representative was presented with a copy of the complete application papers. If the legal representative was not presented with a copy of the application papers, then the legal representative could not attest that he/she has "reviewed and understands the application papers" and rightfully refused to execute the documents which he/she was requested to sign. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers to the legal representative. Did the legal representative receive the application papers? Unless petitioner can show that a copy of the application papers was presented to the legal representative

then petitioner will have to mail a copy of the complete application papers (specification, claims and drawings) to the legal representative last known address, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. Further, rule 47 applicant must state whether Diane Carter is the only legal representative that could sign the declaration on behalf of deceased inventor Kevin Carter. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return, receipt, cover letter of instructions, telegram, etc. See MPEP 409.03(d).

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration **by the party to whom the refusal was made**. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's (or legal representative's) conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor (or legal representative) gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

As to item (2), when an application is filed on behalf of a legal representative, the oath or declaration for the patent application must be signed by the available joint inventors on behalf of the legal representative. The name, residence, post office address and citizenship of the legal representative need to be stated in the declaration in addition to that of the deceased inventor. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the available joint inventors on behalf of themselves and the legal representative is REQUIRED. See MPEP 409.03(a).

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47(a) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, Va 22202

Telephone inquiries related to this decision should be directed
to Karen Creasy at (703) 305-8859.



Frances Hicks
Lead Petitions Examiner
Office of Petition
Office of the Deputy Commissioner
for Patent Examination Policy